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10/578,737	05/10/2006	Jeong-Bong Yoon	1455-061439	5018

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EXAMINER
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KESSLER, CHRISTOPHER S

ART UNIT	PAPER NUMBER
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1793

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/578,737	<b>Applicant(s)</b> YOON ET AL.	
	<b>Examiner</b> CHRISTOPHER KESSLER	<b>Art Unit</b> 1793	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2009.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 83,85 and 87-168 is/are pending in the application.
- 4a) Of the above claim(s) 123-162 and 166-168 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 83,85,87-122 and 163-165 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Responsive to the amendment filed 17 November 2009, claims 83, 95 and 108 are amended and claims 82, 84 and 86 are cancelled. Claims 83, 85, 87-122 and 163-165 are currently under examination.

### ***Status of Previous Rejections***

2. Responsive to the amendment filed 17 November 2009, new grounds of rejection are presented.

### ***Priority***

3. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. PCT/KR04/02901, filed on 10 November 2004.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 99 and 114 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claims 99 and 114 each recite the broad recitation "0.2% or less" for the range of P, and the claim also recites "0.03~0.2" which is the narrower statement of the range/limitation.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 83, 85, 87-122 and 163-165 are rejected under 35 U.S.C. 103(a) as being unpatentable over WIPO document WO 2003/031670 A1 (hereinafter "Murakami").

Regarding claim 83, Murakami teaches the invention substantially as claimed.

Murakami teaches a steel sheet for cylindrical containers (see Abstract, p. 1).

Murakami teaches that the steel is cold-rolled (see claims 10-18 and pp. 14-19).

Murakami teaches the composition of the steel sheet as shown in the chart (see pp. 14-19 and also claims 10-18):

Element	Claim 83	Murakami
C	0.003% or less	0.0005-0.040
S	0.005~0.03%	0.0100-0.0600
Al	0.01~0.1%	0.0010-0.0700
N	0.02% or less	0.0020-0.0300
P	0.03~0.2%	0.002-0.080
Mn	0.05~0.2% *	0.03-2.00
Fe/impurities	Balance	Balance
	Note:	
	* indicates optional element	

The composition of Murakami thus overlaps the range as claimed, establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary

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skill in the art at time of invention to have selected a composition in the range as claimed because Murakami teaches the same utility over an overlapping range.

Applicant is further directed to MPEP 2144.05.

Murakami teaches that the steel has excellent formability (see pp. 7 and 8, abstract). Regarding the limitations of age resistance, ratios of Mn, Cu and S, and size of MnS/CuS inclusions, Murakami further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see pp. 19-24 and claims 17-18, for example). Thus, the steel sheet having the same composition and processed in a similar manner would have been expected by one of ordinary skill in the art to possess the same properties. Applicant is further directed to MPEP 2112.01.

In the alternative, Murakami teaches careful control over the MnS and CuS inclusions (see pp. 17-18). Murakami teaches that the ratio of CuS/MnS  $< 0.30$  through a careful adjustment of the Cu/Mn ratio (see pp. 17-18). Thus, Murakami teaches that the amounts of Mn, Cu and S are results-effective variables with respect to the softening of the material at welding (see pp. 17-18). It would have been obvious to one of ordinary skill in the art at time of invention to have optimized the relative amounts of Mn, Cu and S, because Murakami teaches that these ratios affect the softening of the material (see pp. 17-18). Applicant is further directed to MPEP 2144.05.

Also in the alternative, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620

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O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Mn, Cu and S taught by Murakami fall within the ratios as claimed.

Regarding claim 85, Murakami teaches that the amount of N is 0.0020-0.0300 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of N in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 86, Murakami teaches that the amount of P is 0.002-0.080 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 87, Murakami teaches that the composition comprises 0.002-0.50% Si (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount

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of Si in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 88, Murakami teaches that the amount of N is 0.0020-0.0300 and the amount of P is 0.002-0.080 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected amounts of N and P in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 89, Murakami does not describe the ratio of Al/N as claimed. However it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Al and N taught by Murakami fall within the ratios as claimed.

Regarding claims 90-91, Murakami teaches that the steel may comprise Mo in amount of 0.10 or less (see pp. 13 and 19), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected



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an amount of Mo in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claims 92-94, Murakami teaches that the steel may comprise V in amount of 0.10 or less (see pp. 13 and 19), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of V in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 95, Murakami teaches the invention substantially as claimed. Murakami teaches a steel sheet for cylindrical containers (see Abstract, p. 1). Murakami teaches that the steel is cold-rolled (see claims 10-18 and pp. 14-19). Murakami teaches the composition of the steel sheet as shown in the chart (see pp. 14-19 and also claims 10-18):

Element	Claim 95	Murakami
C	0.0005-0.003% or less	0.0005-0.040
S	0.003-0.025%	0.0100-0.0600
Al	0.01~0.08%	0.0010-0.0700
N	0.02% or less	0.0020-0.0300
P	0.2% or less	0.002-0.080
Cu	0.01~0.2%	0.005-0.050
Fe/impurities	Balance	Balance

	Note:  * indicates optional element	
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The composition of Murakami thus overlaps the range as claimed, establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected a composition in the range as claimed because Murakami teaches the same utility over an overlapping range.

Applicant is further directed to MPEP 2144.05.

Murakami teaches that the steel has excellent formability (see pp. 7 and 8, abstract). Regarding the limitations of age resistance, ratios of Cu and S, and size of CuS inclusions, Murakami further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see pp. 19-24 and claims 17-18, for example). Thus, the steel sheet having the same composition and processed in a similar manner would have been expected by one of ordinary skill in the art to possess the same properties. Applicant is further directed to MPEP 2112.01.

In the alternative, Murakami teaches careful control over the MnS and CuS inclusions (see pp. 17-18). Murakami teaches that the ratio of CuS/MnS < 0.30 through a careful adjustment of the Cu/Mn ratio (see pp. 17-18). Thus, Murakami teaches that the amounts of Mn, Cu and S are results-effective variables with respect to the softening of the material at welding (see pp. 17-18). It would have been obvious to one of ordinary skill in the art at time of invention to have optimized the relative amounts of

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Mn, Cu and S, because Murakami teaches that these ratios affect the softening of the material (see pp. 17-18). Applicant is further directed to MPEP 2144.05.

Also in the alternative, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Cu and S taught by Murakami fall within the ratios as claimed.

Regarding claim 96, Murakami teaches that the amount of P is 0.002-0.080 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Murakami teaches the same utility over an overlapping range.

Applicant is further directed to MPEP 2144.05.

Regarding claim 97, Murakami teaches that the amount of N is 0.0020-0.0300 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of N in the range as claimed because Murakami teaches the same utility over an overlapping range.

Applicant is further directed to MPEP 2144.05.

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Regarding claim 98, Murakami teaches careful control over the MnS and CuS inclusions (see pp. 17-18). Murakami teaches that the ratio of CuS/MnS  $< 0.30$  through a careful adjustment of the Cu/Mn ratio (see pp. 17-18). Thus, Murakami teaches that the amounts of Mn, Cu and S are results-effective variables with respect to the softening of the material at welding (see pp. 17-18). It would have been obvious to one of ordinary skill in the art at time of invention to have optimized the relative amounts of Mn, Cu and S, because Murakami teaches that these ratios affect the softening of the material (see pp. 17-18). Applicant is further directed to MPEP 2144.05.

In the alternative, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Cu and S taught by Murakami fall within the ratios as claimed.

Regarding claim 99, Murakami teaches that the amount of P is 0.002-0.080 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

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Regarding claim 100, Murakami teaches that the composition comprises 0.002-0.50% Si (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Si in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 101, Murakami teaches that the amount of N is 0.0020-0.0300 and the amount of P is 0.002-0.080 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected amounts of N and P in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 102, Murakami does not describe the ratio of Al/N as claimed. However it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Al and N taught by Murakami fall within the ratios as claimed.

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Regarding claims 103-104, Murakami teaches that the steel may comprise Mo in amount of 0.10 or less (see pp. 13 and 19), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Mo in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claims 105-107, Murakami teaches that the steel may comprise V in amount of 0.10 or less (see pp. 13 and 19), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of V in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 108, Murakami teaches the invention substantially as claimed. Murakami teaches a steel sheet for cylindrical containers (see Abstract, p. 1). Murakami teaches that the steel is cold-rolled (see claims 10-18 and pp. 14-19). Murakami teaches the composition of the steel sheet as shown in the chart (see pp. 14-19 and also claims 10-18):

Element	Claim 108	Murakami
C	0.0005-0.003% or less	0.0005-0.040
S	0.003-0.025%	0.0100-0.0600
Al	0.01-0.08%	0.0010-0.0700

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N	0.02% or less	0.0020-0.0300
P	0.2% or less	0.002-0.080
Mn	0.03-0.2% *	0.03-2.00
Cu	0.005-0.2% *	0.005-0.050*
Fe/impurities	Balance	Balance
	Note:	
	* indicates optional element	

The composition of Murakami thus overlaps the range as claimed, establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected a composition in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Murakami teaches that the steel has excellent formability (see pp. 7 and 8, abstract). Regarding the limitations of age resistance, ratios of Mn, Cu and S, and size of MnS/CuS inclusions, Murakami further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see pp. 19-24 and claims 17-18, for example). Thus, the steel sheet having the same composition and processed in a similar manner would have been expected by one of ordinary skill in the art to possess the same properties. Applicant is further directed to MPEP 2112.01.

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In the alternative, Murakami teaches careful control over the MnS and CuS inclusions (see pp. 17-18). Murakami teaches that the ratio of CuS/MnS  $< 0.30$  through a careful adjustment of the Cu/Mn ratio (see pp. 17-18). Thus, Murakami teaches that the amounts of Mn, Cu and S are results-effective variables with respect to the softening of the material at welding (see pp. 17-18). It would have been obvious to one of ordinary skill in the art at time of invention to have optimized the relative amounts of Mn, Cu and S, because Murakami teaches that these ratios affect the softening of the material (see pp. 17-18). Applicant is further directed to MPEP 2144.05.

Also in the alternative, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Mn, Cu and S taught by Murakami fall within the ratios as claimed.

Regarding claim 109, Murakami teaches that the amount of P is 0.002-0.080 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.



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Regarding claim 110, Murakami teaches that the amount of N is 0.0020-0.0300 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of N in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 111, Murakami does not teach the number of precipitates. Murakami further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see pp. 19-24 and claims 17-18, for example). Thus, the steel sheet having the same composition and processed in a similar manner would have been expected by one of ordinary skill in the art to possess the same properties. Applicant is further directed to MPEP 2112.01.

Regarding claim 112, Murakami teaches careful control over the MnS and CuS inclusions (see pp. 17-18). Murakami teaches that the ratio of CuS/MnS  $< 0.30$  through a careful adjustment of the Cu/Mn ratio (see pp. 17-18). Thus, Murakami teaches that the amounts of Mn, Cu and S are results-effective variables with respect to the softening of the material at welding (see pp. 17-18). It would have been obvious to one of ordinary skill in the art at time of invention to have optimized the relative amounts of Mn, Cu and S, because Murakami teaches that these ratios affect the softening of the material (see pp. 17-18). Applicant is further directed to MPEP 2144.05.

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Also in the alternative, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Mn, Cu and S taught by Murakami fall within the ratios as claimed.

Regarding claim 113, Murakami does not teach the number of precipitates. Murakami further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see pp. 19-24 and claims 17-18, for example). Thus, the steel sheet having the same composition and processed in a similar manner would have been expected by one of ordinary skill in the art to possess the same properties. Applicant is further directed to MPEP 2112.01.

Regarding claim 114, Murakami teaches that the amount of P is 0.002-0.080 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

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Regarding claim 115, Murakami teaches that the composition comprises 0.002-0.50% Si (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Si in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 116, Murakami teaches that the amount of N is 0.0020-0.0300 and the amount of P is 0.002-0.080 (see claims 10-18), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected amounts of N and P in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 117, Murakami does not describe the ratio of Al/N as claimed. However it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Al and N taught by Murakami fall within the ratios as claimed.

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Regarding claim 118, Murakami teaches that the steel may comprise Mo in amount of 0.10 or less (see pp. 13 and 19), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Mo in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claims 119-122, Murakami teaches that the steel may comprise V in amount of 0.10 or less (see pp. 13 and 19), said range overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of V in the range as claimed because Murakami teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claims 163-165, Murakami does not describe the ratio of V/C as claimed. However it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of V and C taught by Murakami fall within the ratios as claimed.

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8. Claims 83, 85, 87-122 and 163-165 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent document JP 10-158782 (machine translation attached; hereinafter "Kodama").

Regarding claim 83, Kodama teaches the invention substantially as claimed. Kodama teaches a steel sheet (plate) for photograph etching (see [0001]). Kodama teaches the composition of the steel sheet as shown in the chart (see [0008], [0015]-[0021] and also claims 1 and 2):

Element	Claim 83	Kodama
C	0.003% or less	0.005% or less
S	0.005~0.03%	0.001-0.02%
Al	0.01~0.1%	0.002-0.1%
N	0.02% or less	0.008% or less
P	0.03~0.2%	0.1% or less*
Mn	0.05~0.2%	0.1-0.5%
Fe/impurities	Balance	Balance
	Note: * indicates optional element	

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The composition of Kodama thus overlaps the range as claimed, establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected a composition in the range as claimed because Kodama teaches the same utility over an overlapping range.

Applicant is further directed to MPEP 2144.05.

Kodama teaches that the invention involves forming many holes in the steel sheet (i.e., the sheet is saccavous; see [0001]-[0004]). Kodama teaches that the MnS inclusions affect the ability to etch the holes in the sheet, and that the size of the MnS inclusions is thus limited such that a  $2\sigma$  value of particle size falls within 0.05-2  $\mu\text{m}$  (see [00011]-[0013], [0008], and claim 1). The particle size range of the MnS inclusions in the steel of Kodama overlaps the size as claimed, establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected a particles size of MnS inclusions in the range as claimed because Kodama teaches the same utility over an overlapping range.

Applicant is further directed to MPEP 2144.05.

Kodama teaches that the sheet is cold rolled (see [0009]-[0010], claims 2 and 3, and [0036]-[0038]). Regarding the limitations of the relative ratios of Mn and S, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more

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than routine investigation by those of ordinary skill in the art. In re Austin, et al., 149 USPQ 685, 688. In the instant case, the amounts of Mn and S taught by Kodama fall within the ratios as claimed.

In the alternative, Kodama teaches that the amounts of both Mn and S are carefully controlled in the steel (see [0017]-[0018]). Kodama teaches that too little Mn does not prevent brittleness, while too much Mn causes too much hardness in the steel (see [0017]). Kodama teaches that too little S results in poorly formed nitrides, while too much S results in cracking during hot rolling (see [0018]). Thus the amounts of Mn and S are results-effective variables, respectively, and one of ordinary skill in the art would have optimized the amounts of each (and thus optimized the relative ratio) for the reasons taught by Kodama and cited above. Applicant is further directed to MPEP 2144.05.

Regarding the limitation of "having aging resistance," there is no quantity of aging resistance claimed. Thus the sheet of Kodama would have inherently had an aging resistance, because it would have been able to support some load prior to stretcher strain or creep failure. Applicant is further directed to MPEP 2111 and 2112.01.

Regarding claim 85, Kodama teaches wherein the N content is preferably 0.004% or less (see [0020]).

Regarding claim 87, Kodama teaches that 0.1% of Cr may be added to the steel (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Cr in the range as claimed because

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Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 88, Kodama teaches that the amount of N is preferably 0.008% or less (see [0020]), and that P may be added in an amount of 0.1% or less (see [0021]). The amounts of N and P in the steel of Kodama overlap the ranges as claimed, establishing a prima facie case of obviousness for the ranges. It would have been obvious to one of ordinary skill in the art at time of invention to have selected amounts of N and P in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 89, Kodama does not describe the ratio of Al/N as claimed. However it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Al and N taught by Kodama overlap the ratios as claimed.

In the alternative, Kodama teaches that the amount of Al in the steel serves to fix free N as AlN (see [0019]). Thus, Kodama teaches that the amount of Al is a results-effective variable with regard to AlN formation, and the amount of Al relative to N would



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have been optimized by one of ordinary skill in the art at time of invention in order to control the AIN formation. Applicant is further directed to MPEP 2144.05.

Regarding claims 90-91, Kodama teaches that 0.1% or less of Mo may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Mo in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claims 92-94, Kodama teaches that 0.1% or less of V may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of V in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 95, Kodama is applied to the claim as stated above. Kodama teaches the composition of the steel sheet as shown in the chart (see [0008], [0015]-[0021] and also claims 1 and 2):

Element	Claim 95	Kodama
C	0.0005-0.003% or less	0.005% or less
S	0.003-0.025%	0.001-0.02%
Al	0.01~0.08%	0.002-0.1%

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N	0.02% or less	0.008% or less
P	0.2% or less	0.1% or less*
Cu	0.01~0.2%	0.1% or less*
Fe/impurities	Balance	Balance
	Note:	
	* indicates optional element	

The composition of Kodama thus overlaps the range as claimed, establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected a composition in the range as claimed because Kodama teaches the same utility over an overlapping range.

Applicant is further directed to MPEP 2144.05.

Regarding the limitations of age resistance and size of CuS inclusions, Kodama further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see [0009]-[0010], claims 2 and 3, and [0036]-[0038]). Thus, the steel sheet having the same composition and processed in a similar manner would have been expected by one of ordinary skill in the art to possess the same properties.

Applicant is further directed to MPEP 2112.01.

Regarding the limitations of the relative ratios of Cu and S, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57

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USPQ 117, Taklatwalla v. Marburg, 620 O.G. 685, 1949 C.D. 77, and In re Pilling, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. In re Austin, et al., 149 USPQ 685, 688. In the instant case, the amounts of Cu and S taught by Kodama fall within the ratios as claimed.

In the alternative, Kodama teaches that the amounts of S are carefully controlled in the steel (see [0017]-[0018]). Kodama teaches that too little S results in poorly formed nitrides, while too much S results in cracking during hot rolling (see [0018]). Thus the amount S is a results-effective variable, respectively, and one of ordinary skill in the art would have optimized the amount of S (and thus optimized the relative ratio) for the reasons taught by Kodama and cited above. Applicant is further directed to MPEP 2144.05.

Regarding claim 96, Kodama teaches that 0.1% or less of P may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 97, Kodama teaches wherein the N content is preferably 0.004% or less (see [0020]).

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Regarding claim 98, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Cu and S taught by Kodama fall within the ratios as claimed.

In the alternative, Kodama teaches that the amounts of S are carefully controlled in the steel (see [0017]-[0018]). Kodama teaches that too little Mn does not prevent brittleness, while too much Mn causes too much hardness in the steel (see [0017]). Kodama teaches that too little S results in poorly formed nitrides, while too much S results in cracking during hot rolling (see [0018]). Thus the amount S is a results-effective variable, respectively, and one of ordinary skill in the art would have optimized the amount of S (and thus optimized the relative ratio) for the reasons taught by Kodama and cited above. Applicant is further directed to MPEP 2144.05.

Regarding claim 99, Kodama teaches that 0.1% or less of P may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

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Regarding claim 100, Kodama teaches that 0.1% of Cr may be added to the steel (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Cr in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 101, Kodama teaches that the amount of N is preferably 0.008% or less (see [0020]), and that P may be added in an amount of 0.1% or less (see [0021]). The amounts of N and P in the steel of Kodama overlap the ranges as claimed, establishing a prima facie case of obviousness for the ranges. It would have been obvious to one of ordinary skill in the art at time of invention to have selected amounts of N and P in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 102, Kodama does not describe the ratio of Al/N as claimed. However it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Al and N taught by Kodama overlap the ratios as claimed.

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In the alternative, Kodama teaches that the amount of Al in the steel serves to fix free N as AlN (see [0019]). Thus, Kodama teaches that the amount of Al is a results-effective variable with regard to AlN formation, and the amount of Al relative to N would have been optimized by one of ordinary skill in the art at time of invention in order to control the AlN formation. Applicant is further directed to MPEP 2144.05.

Regarding claims 103-104, Kodama teaches that 0.1% or less of Mo may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Mo in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claims 105-107, Kodama teaches that 0.1% or less of V may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of V in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 108, Kodama is applied to the claim as stated above. Kodama teaches the composition of the steel sheet as shown in the chart (see [0008], [0015]-[0021] and also claims 1 and 2):

Element	Claim 108	Kodama
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C	0.0005-0.003% or less	0.005% or less
S	0.003-0.025%	0.001-0.02%
Al	0.01-0.08%	0.002-0.1%
N	0.02% or less	0.008% or less
P	0.2% or less	0.1% or less*
Mn	0.03-0.2% *	0.1-0.5%
Cu	0.005-0.2% *	0.1% or less*
Fe/impurities	Balance	Balance
	Note:	
	* indicates optional element	

The composition of Kodama thus overlaps the range as claimed, establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected a composition in the range as claimed because Kodama teaches the same utility over an overlapping range.

Applicant is further directed to MPEP 2144.05.

Regarding the limitations of age resistance and size of MnS and CuS inclusions, Kodama further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see [0009]-[0010], claims 2 and 3, and [0036]-[0038]). Thus, the steel sheet having the same composition and processed in a similar manner

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would have been expected by one of ordinary skill in the art to possess the same properties. Applicant is further directed to MPEP 2112.01.

Furtehr, Kodama teaches that the MnS inclusions affect the ability to etch the holes in the sheet, and that the size of the MnS inclusions is thus limited such that a  $2\sigma$  value of particle size falls within 0.05-2  $\mu\text{m}$  (see [00011]-[0013], [0008], and claim 1). The particle size range of the MnS inclusions in the steel of Kodama overlaps the size as claimed, establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected a particles size of MnS inclusions in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding the limitations of the relative ratios of Mn, Cu and S, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Mn, Cu and S taught by Kodama fall within the ratios as claimed.

In the alternative, Kodama teaches that the amounts of both Mn and S are carefully controlled in the steel (see [0017]-[0018]). Kodama teaches that too little Mn does not prevent brittleness, while too much Mn causes too much hardness in the steel



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(see [0017]). Kodama teaches that too little S results in poorly formed nitrides, while too much S results in cracking during hot rolling (see [0018]). Thus the amounts of Mn and S are results-effective variables, respectively, and one of ordinary skill in the art would have optimized the amounts of each (and thus optimized the relative ratio of Mn, S and Cu) for the reasons taught by Kodama and cited above. Applicant is further directed to MPEP 2144.05.

Regarding claim 109, Kodama teaches that 0.1% or less of P may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 110, Kodama teaches wherein the N content is preferably 0.004% or less (see [0020]).

Regarding claim 111, Kodama does not specify what is the number of precipitates in the steel. Kodama further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see [0009]-[0010], claims 2 and 3, and [0036]-[0038]). Thus, the steel sheet having the same composition and processed in a similar manner would have been expected by one of ordinary skill in the art to possess the same properties. Applicant is further directed to MPEP 2112.01.

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Regarding claim 112, it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Mn, Cu and S taught by Kodama fall within the ratios as claimed.

In the alternative, Kodama teaches that the amounts of both Mn and S are carefully controlled in the steel (see [0017]-[0018]). Kodama teaches that too little Mn does not prevent brittleness, while too much Mn causes too much hardness in the steel (see [0017]). Kodama teaches that too little S results in poorly formed nitrides, while too much S results in cracking during hot rolling (see [0018]). Thus the amounts of Mn and S are results-effective variables, respectively, and one of ordinary skill in the art would have optimized the amounts of each (and thus optimized the relative ratio of Mn, S and Cu) for the reasons taught by Kodama and cited above. Applicant is further directed to MPEP 2144.05.

Regarding claim 113, Kodama does not specify what is the number of precipitates in the steel. Kodama further teaches that the steel is processed in a manner including hot rolling, a controlled cooling, cold rolling and continuous annealing steps substantially similar to those of the instant invention (see [0009]-[0010], claims 2 and 3, and [0036]-[0038]). Thus, the steel sheet having the same composition and

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processed in a similar manner would have been expected by one of ordinary skill in the art to possess the same properties. Applicant is further directed to MPEP 2112.01.

Regarding claim 114, Kodama teaches that 0.1% or less of P may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of P in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 115, Kodama teaches that 0.1% of Cr may be added to the steel (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Cr in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claim 116, Kodama teaches that the amount of N is preferably 0.008% or less (see [0020]), and that P may be added in an amount of 0.1% or less (see [0021]). The amounts of N and P in the steel of Kodama overlap the ranges as claimed, establishing a prima facie case of obviousness for the ranges. It would have been obvious to one of ordinary skill in the art at time of invention to have selected amounts of N and P in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

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Regarding claim 117, Kodama does not describe the ratio of Al/N as claimed. However it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of Al and N taught by Kodama overlap the ratios as claimed.

In the alternative, Kodama teaches that the amount of Al in the steel serves to fix free N as AlN (see [0019]). Thus, Kodama teaches that the amount of Al is a results-effective variable with regard to AlN formation, and the amount of Al relative to N would have been optimized by one of ordinary skill in the art at time of invention in order to control the AlN formation. Applicant is further directed to MPEP 2144.05.

Regarding claims 118-119, Kodama teaches that 0.1% or less of Mo may be added (see [0021]), overlapping the range as claimed and establishing a prima facie case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of Mo in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claims 120-122, Kodama teaches that 0.1% or less of V may be added (see [0021]), overlapping the range as claimed and establishing a prima facie

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case of obviousness for that range. It would have been obvious to one of ordinary skill in the art at time of invention to have selected an amount of V in the range as claimed because Kodama teaches the same utility over an overlapping range. Applicant is further directed to MPEP 2144.05.

Regarding claims 163-165, Kodama does not describe the ratio of V/C as claimed. However it is well settled that there is no invention in the discovery of a general formula if it covers a composition described in the prior art, *In re Cooper and Foley* 1943 C.D. 357, 553 O.G. 177; 57 USPQ 117, *Taklatwalla v. Marburg*, 620 O.G. 685, 1949 C.D. 77, and *In re Pilling*, 403 O.G. 513, 44 F(2) 878, 1931 C.D. 75. In the absence of evidence to the contrary, the selection of the proportions of elements would appear to require no more than routine investigation by those of ordinary skill in the art. *In re Austin, et al.*, 149 USPQ 685, 688. In the instant case, the amounts of V and C taught by Kodama fall within the ratios as claimed.

### ***Response to Arguments***

9. Applicant's arguments filed 17 November 2009 have been fully considered but they are not persuasive.

Applicant argues that Hayashida does not teach the steel sheet claimed in claim 83. This argument is moot in view of new grounds of rejection.

Applicant argues that the steel sheet of claims 83, 95 and 108, respectively, is different from the steel sheet of Murakami because Murakami is directed to a different end use for the steel sheet. This argument is not persuasive, because the intended use

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is not a part of the claims, and if it were, would still not serve to distinguish the structure of the claimed steel from that of the steel of the prior art.

Applicant argues that Murakami fails to teach or suggest the claimed ranges of Mn/S, Cu/S, Mn+Cu, (Mn+Cu)/S, or the average size of the MnS, CuS and (Mn,Cu)S precipitates. The examiner agrees that Murakami does not explicitly describe these features, and has already stated such to be the case. However, the examiner believes said features would have been obvious to one of ordinary skill in the art for the reasons stated above. Applicant argues that the cold rolled sheet of the instant claims has high yield strength and other desirable mechanical properties due to the control of said claim features. However, the mechanical properties of the steel are not claimed. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., high yield strength and balance of strength-ductility and workability) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Further, applicant has shown no evidence that these properties would not have been present in the prior art.

In the remarks of 17 November 2009, at page 17, applicant states,

The Murakami publication discloses a steel sheet that includes 0.01-0.06 weight percent S and 0.0005-0.05 weight percent Cu. Accordingly, the Murakami publication discloses a range of  $0.5 \times \text{Cu/S}$  of 0.025-0.417. This range does not fall within the claimed range of 1-10. Accordingly, the Murakami publication does not teach or suggest that the composition of Cu and S satisfies the relationship  $1 \leq 0.5 \times \text{Cu/S} \leq 10$  as required by claim 95.

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The examiner disagrees with applicant's statements because they are factually incorrect. According to the examiner's calculations, the lowest possible range for  $0.5^*Cu/S$  of Murakami is 0.0047 (e.g.,  $0.5^*Cu/S = 0.5^*0.0005/0.06 = 0.00417$ ), while the highest possible range for  $0.5^*Cu/S$  of Murakami is 2.5 (e.g.,  $0.5^*Cu/S = 0.5^*0.05/0.01 = 2.5$ ). Thus, the **actual** range inherently taught by Murakami for  $0.5^*Cu/S$  is 0.00417 - 2.5. As was stated previously, said range overlaps the claimed range, establishing a *prima facie* case of obviousness, and further, one of ordinary skill in the art would have optimized the amounts of Cu and S for the reasons stated in the rejection.

### **Conclusion**

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER KESSLER whose telephone number is (571)272-6510. The examiner can normally be reached on Mon-Fri, 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Roy King/  
Supervisory Patent Examiner, Art  
Unit 1793

csk